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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,446	12/13/2000	Thomas P. Murphy	56945.000004	7890

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EXAMINER
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CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/735,446

Applicant(s)

MURPHY ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

3622

*mw*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

*JDC*

### DETAILED ACTION

1. This action is responsive to the paper(s) filed 3/2/04.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kepecs (US6330543) in view of Walker et al ('207) (US5794207).

Regarding claim 1, 2, 5, 8, 11, 23, 24, Kepecs teaches a centralized host which provides an online promotion (incentive) system. Users remotely log in and browse offers that are targeted to them. The new user registration process [3:1-8] is taken to meet part c) of claim 1; any user-submitted data during such a process is taken to be transmission of a user-submitted profile. A user may "select" an offer online and then "redeem" the offer at a retail location which may include a discount at the time of purchase [2:23-34, 5:18-60, 11:4-30]. The communication from the central host to the POS detailing the qualification for discount/offer is taken to be disbursement of a redeemable electronic certificate. Kepecs does not teach details for user fees. Official Notice is taken that it is well known to charge users for services and to refund fees if the users follow through and make purchases. It would have been obvious to one of ordinary skill at the time of the invention to have charged users a fee to their authorized

Art Unit: 3622

credit card or other financial account associated with the targeted offering of promotions and to have waived or refunded fees if the users make purchases using the system.

This step of charging a user fee is taken to include notification of the required fee, prompting for such a fee, submission of the fee/fee payment information, collection of the fee/fee payment information and delivery of the incentive in association with the fee.

Kepecs teaches that the system can automatically "compute discounts" based on customer and product information. Formulas control system feedback and automatically modify promotions based on customer behavior [14:13-21]. Kepecs does not however teach customers suggesting prices or offer parameters. Walker et al ('207) however teaches a centralized, online system where users are allowed to submit offers to the system with customized, user-defined offer parameters. The system evaluates the user offers and either accepts or denies them. It would have been obvious to one of ordinary skill at the time of the invention to have provided the customized promotion system of Kepecs with the ability for user-defined offer parameters, so that users can take advantage of more appealing customized promotions. Redemption of an incentive associated with a user requires user identification at the retail location [5:45-50]; therefore the disbursement of a redeemable electronic certificate also must include user identification to accomplish such.

Regarding claim 3, 9, Kepecs teaches the use of a user printing a targeted coupon and presenting it at the retail location [1:48-51].

Regarding claim 4, 10, Kepecs teaches user registration/identification including name, address and email address [4:42-46, 3:6-7].

Art Unit: 3622

Regarding claim 6, 12, 25, Kepecs teaches manufacturers providing the promotions as well as funding them in the hopes of increased sales. It would have been obvious to one of ordinary skill at the time of the invention to have provided the system of Kepecs for promoting the sales of any type of good or service, including vehicles.

Regarding claim 7, 13, 15, 16, 17, Kepecs teaches that the identified user's profile is used to determine the offers for which the user qualifies (offers are targeted, individualized discounts determined through comparison/matching of users and offers) [6:63-68]. Kepecs also teaches keeping track of the user's online history including offer selection and even offer viewing [3:9-18].

Regarding claim 14, 19-22, Walker et al ('207) teaches that the system can process the user defined offer and return a modified offer (counter-offer) [22:39-43].

Regarding claim 18, 26-28, Kepecs teaches the use of a remote user graphical user interface (GUI) [11:8-10] and it would have been obvious to one of ordinary skill at the time of the invention to have used such a GUI interface for users to input the user-defined/customized incentive parameters/data fields, so as to make the computerized system user-friendly.

### ***Response to Arguments***

Applicant's arguments filed 3/2/04 have been fully considered but they are not persuasive. Applicant argues that the references fail to teach the invention by merely reciting substantial portions of the claims purportedly not met by the references.

Examiner assumes that the italicized language are the particular features not met by the

Art Unit: 3622

references. However, applicant does not dispute any of Examiner's statements which address the claim limitations. For example, applicant apparently argues that the references fail to teach claim 7's features of comparing qualification criteria to determine which incentives should be made available to the user. However, applicant neither address examiner's statement regarding such feature nor rebuts it:

*"Regarding claim 7, 13, 15, 16, 17, Kepecs teaches that the identified user's profile is used to determine the offers for which the user qualifies (offers are targeted, individualized discounts determined through comparison/matching of users and offers) [6:63-68]. Kepecs also teaches keeping track of the user's online history including offer selection and even offer viewing [3:9-18]."*

Each limitation regarding applicant's arguments are believed to be properly set forth and addressed as above.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3622

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc